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PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)


REC'D 27 AUG 2004

WIPO PCT

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Applicant's or agent's file reference EMBR-014		FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA/416)	
International application No. PCT/BR 03/00085	International filing date (day/month/year) 01.07.2003	Priority date (day/month/year) 03.07.2002	
International Patent Classification (IPC) or both national classification and IPC H02K1/14			
Applicant EMPRESA BRASILEIRA DE COMPRESSORES S/A ... et al.			

<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 6 sheets, including this cover sheet.</p> <p><input checked="" type="checkbox"/> This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of 4 sheets.</p>	
<p>3. This report contains indications relating to the following items:</p> <p>I <input checked="" type="checkbox"/> Basis of the opinion</p> <p>II <input type="checkbox"/> Priority</p> <p>III <input type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p>IV <input type="checkbox"/> Lack of unity of invention</p> <p>V <input checked="" type="checkbox"/> Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p>VI <input type="checkbox"/> Certain documents cited</p> <p>VII <input type="checkbox"/> Certain defects in the international application</p> <p>VIII <input type="checkbox"/> Certain observations on the international application</p>	

Date of submission of the demand 02.02.2004	Date of completion of this report 26.08.2004
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer Kampka, A Telephone No. +49 89 2399-2244



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International application No. **PCT/BR 03/00085**

I. Basis of the report

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

Description, Pages

1-9 as originally filed

Claims, Numbers

1-14 received on 13.07.2004 with letter of 01.07.2004

Drawings, Sheets

1/3-3/3 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b));
☐ the language of publication of the international application (under Rule 48.3(b));
☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority in written form.
☐ furnished subsequently to this Authority in computer readable form.
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
☒ the claims, Nos.: 15
☐ the drawings, sheets:

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5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	1
	No: Claims	11,14
Inventive step (IS)	Yes: Claims	1
	No: Claims	11,14
Industrial applicability (IA)	Yes: Claims	1,11,14
	No: Claims	

2. Citations and explanations

see separate sheet

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Re Item V

Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

Reference is made to the following documents:

- D1: US-A-5 318 412 (LASKARIS ET AL.) 7 June 1994 (1994-06-07)
- D2: US-A-6 077 054 (LEE ET AL.) 20 June 2000 (2000-06-20)
- D3: PATENT ABSTRACTS OF JAPAN vol. 2002, no. 10, 10 October 2002 (2002-10-10) -& JP 2002 171740 A (LG ELECTRONICS INC), 14 June 2002 (2002-06-14)
- D4: US-A-6 060 810 (LEE ET AL.) 9 May 2000 (2000-05-09)
- D5: US-A-5 945 748 (PARK ET AL.) 31 August 1999 (1999-08-31)

1. The set of claims 1 - 14 contains three independent claims (claims 1, 11 and 14) with claim 1 formulated as independent process claim and claims 11 and 14 formulated as independent claims for physical entities. The present claim set is not clear and concise, because it contains an unnecessary plurality of independent device claims, contrary to the requirements of Art. 6 PCT. The applicant is informed that in the European Patent Office, the official interpretation of the requirement of conciseness under Art. 6 PCT is that only in exceptional cases more than a single independent claim per category (process, device) is appropriate (such examples are e.g.: plug and socket, transmitter and receiver, further medical uses, alternative - unitary - solutions to a particular problem). This does not apply in the present case, where the independent device claims are clearly not directed to interrelated products such as given in the above examples. Therefore, the application does not meet the requirement of conciseness of Art. 6 PCT. In the present case, one independent claim in each category (process, device) is considered appropriate.
2. The present application does not satisfy the criterion set forth in Art. 33(2) PCT because the subject-matter of independent claims 11 and 14 is not new.

In the opinion of the examiner, document D1 discloses (see Fig. 1 and 2, in particular references 12a, 12b and 18 with column 3, lines 6 - 15) all essential features of independent claims 11 and 14. Therefore, it appears that the subject-matter of independent claims 11 and 14 is not new.

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Furthermore, also document D2 discloses (see Fig. 4 with column 3, lines 58 - 67 15) all essential features of independent claims 11 and 14. Therefore, it appears that the subject-matter of independent claims 11 and 14 is not new also having regard to D2.

3. Since novelty is a necessary condition for an inventive step, the present application does not satisfy the criterion set forth in Art. 33(3) PCT.
4. Independent claim 1 was derived from independent claim 1 as filed plus dependent claim 11 as filed. D1 as well as D2 (each document taken alone) disclose the features of claim 1 as filed, i.e. method steps a,e,f of claim 1 filed with the letter dated 01.07.2004, however, neither of documents D1 - D5 cited in the Search Report, disclose the features of claim 11 as filed, i.e. method steps b,c,d of claim 1 filed with the letter dated 01.07.2004. Therefore, the subject-matter of claim 1 cannot be obtained in an obvious way by any combination of D1 - D5.

D1 and D2 disclose homogenous internal surfaces. The applicant argues that the process of claim 1 leads to substantially homogenous internal and external surfaces. The examiner accepts that the lamination elements of D1 as well as D2,

do not lead to a homogenous external surface (see D1, Fig. 2 and D2, Fig. 4). Therefore, starting from D1, the process of claim 1 solves the problem of providing substantially homogenous internal and external surfaces.

Therefore, claim 1 meets the criteria set forth in Art. 33(1) PCT with respect to the available prior art.

Additional remarks:

The claims are drafted in the two-part form, however, all the features known from D1 should have been placed in the preamble (Rule 6.3(b) PCT). Process claims could also be filed in the one-part-form to provide a logical sequence of process steps.

In order to meet the requirements of Rule 5.1(a)(ii) PCT, D1 and D2 should have been cited in the description and the relevant background art disclosed therein should have been briefly discussed.

The definition of the invention in the description should have been adapted to the

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new claims to be filed to avoid inconsistencies which could lead to unclarity if the claims are read together with the description, Art. 6 PCT. Such inconsistency arises, if features which were introduced in the independent claim are defined as belonging to preferred embodiments in the description, or if features are defined as belonging to the invention, which are not defined in the independent claim. To avoid such inconsistencies the "summary of the invention" on page 2, last paragraph - page 3, penultimate paragraph should have been adapted to the amended claims.